REMARKS

Applicants acknowledge receipt of an Office Action dated October 7, 2004. In this response Applicants have amended claims 1, 14, and 17. Support for these amendments may be found in Applicants' disclosure, *inter alia*, in the paragraph bridging pages 7 and 8 of the specification and in the first full paragraph on page 14 of the specification. Following entry of these amendments, claims 1-17 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Rejections Under 35 U.S.C. § 112

On page 2 of the Office Action, the PTO has rejected claims 1-17 under 35 U.S.C. § 112, second paragraph, as being indefinite. As set forth below, Applicants respectfully traverse this rejection.

With respect to claims 1-13 and 17, Applicants note that the first full paragraph on page 14 of the specification discusses the term "mixture." Specifically, the first full paragraph on page 14 of the specification states that:

> The term 'mixture' referred herein [sic] means not only a mixture containing the rare earth magnet powder and the rare earth oxide powder simply mixed with each other, but also a product containing rare earth magnet powder and the rare earth oxide powder which are physically or chemically bound with each other.

In this response, Applicants have amended claims 1 and 17, so that each claim now recites that "the rare earth magnet particles and the rare earth oxide are physically or chemically bound together" and so that it is clear that claims 1 and 17 do not refer to a collection of unbound particles.

With respect to claims 14-16, Applicants refer to the discussion under the heading "[Preparation of Mixture]" on pages 13 and 14 of the specification and to the discussion under the heading "[Forming of Mixture]" on pages 15 and 16 of the specification. Applicants submit that these passages describe the differences between preparing a mixture and forming a mixture. In addition, in this response, Applicants have amended claim 14 to

recite "wherein the step of forming the mixture comprises physically or chemically bonding together the rare earth magnet powder and the rare earth oxide powder."

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §112.

Rejections Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,762,574 to Ghandehari (hereafter "Ghandehari), Japanese Patent Publication 2002-064010 (JP '010) or Japanese Patent Publication No. 2000-082610 (JP '610). Applicants respectfully traverse these rejections for the reasons set forth below.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). *See* MPEP §2143.03.

Here, no permutation of teachings from Ghadehari, JP '010 and JP '610 could have suggested: (a) a rare earth magnet comprising a rare earth oxide "represented by the following general formula (I): $R_{2x}R'_{2(1-x)}O_3$" and "wherein R and R' refer to different elements," as recited in independent claim 1; (b) a process for producing a rare earth magnet comprising a rare earth oxide "represented by the following general formula (I): $R_{2x}R'_{2(1-x)}O_3$" and "wherein R and R' refer to different elements," as recited in claim 14; or (c) a motor comprising a rare earth magnet which includes a rare earth oxide "represented by the following general formula (I): $R_{2x}R'_{2(1-x)}O_3$. . . wherein R and R' refer to different elements," as recited in claim 17.

Applicants note that the PTO has acknowledged, at lines 9-14 on page 4 of the Office Action, that the references do not disclose a rare earth oxide represented by the formula $R_{2x}R'_{x(1-x)}O_3$ wherein R and R' are different from each other.

The presently claimed rare earth magnets provide a number of advantageous effects that are nowhere suggested or taught in any of the cited references, whether considered individually or in combination. These advantages include, for example,:

- The presently claimed rare earth magnet comprising the presently claimed rare earth oxide has a high electrical resistance.

- The presently claimed rare earth magnet comprising the presently claimed rare earth oxide has excellent magnetic characteristics even when severe processing condition, such as pressure sintering, are employed.
- The presently claimed rare earth magnet comprising the presently claimed rare earth oxide has high heat resistance as a result of the present of the oxide which provides sufficient insulation even after exposure to high temperature conditions, such as during pressure sintering.

See page 5, line 13-page 7, line 16 of the Specification for a more detailed discussion of these advantages.

For these reasons, Applicants submit that the rejections of claims 1, 14 and 17 ought to be withdrawn.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). *See* MPEP 2143.03. Thus, Applicants submit that claims 2-13, each of which ultimately depends from independent claim 1, and claims 15-16, each of which depends directly from claim 14, are also non-obvious.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under §103.

Double Patenting/Provisional Rejection Under 35 U.S.C. §103(a)

On page 4 of the Office Action, the PTO has rejected claims 1-17 under the judicially created doctrine of obviousness-type patenting as being unpatentable over claims 1-8 of U.S. Patent Application Serial Number 10,600,602, which has now been published as U.S. Patent Publication 2004/0000359 (hereafter "'602 application"). Applicants are filing, concurrently with this response, a terminal disclaimer. In view of the submission of the terminal disclaimer, Applicants submit that the obviousness-type double patenting rejection is now moot.

On page 6 of the Office Action, the PTO has provisionally rejected claims 1-17 under 35 U.S.C. §103(a), in view of the '602 application. In response to this rejection, Applicants note that Application 10/809,422 and Application 10/600,602 were, at the time the invention of Application 10/809,422 was made, owned by Nissan Motor Co., Ltd. Applicants submit

that this statement, in accordance with MPEP §706.02(l)(2)(II.), is sufficient to overcome the provisional §103(a) rejection.

In view of the foregoing, Applicants respectfully request withdrawal of the provisional obviousness-type double patenting rejection and the provisional §103(a) rejection based upon the '602 application.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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